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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,390	07/17/2003	Jen-Shou Tseng	9610-US-PA	1389

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BERKELEY LAW & TECHNOLOGY GROUP, LLP  
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BEAVERTON, OR 97006

EXAMINER
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CHAN, KO HUNG

ART UNIT	PAPER NUMBER
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3632

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/604,390	Applicant(s) TSENG ET AL.	
	Examiner Korie H. Chan	Art Unit 3632	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6,9-15,18 and 21-36 is/are pending in the application.  
4a) Of the above claim(s) 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,9-15,18, 21-29, 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

Newly submitted claims 30-33 which we'll call group II are directed to an inventions that is independent or distinct from the invention originally claimed (which we'll call group I) for the following reasons: Group II, claims 30-33 are directed to the method of using the product of group I.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product (supporting structure) can be used in a materially different process of using the product such as using the supporting structure for a circuit board support as in the prior art of Kakizki et al (US patent no. 5,633,461).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims claims 13-15, 18, 21-26 and 30-33 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

Claims 1, 2, 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kakizaki et al (US patent no. 5,633,461). Kakizaki discloses a case body (18) for a platform (16) comprising: a housing (18) having an opening on which the platform is placed, and one or more support elements (17) mounted on interior walls of the housing, at least one of the support elements comprising: a supporting surface (19, figure 6, 7) on a top of each support element configured to contact the platform; and an absorbing body (17a or 17d) located beneath the supporting surface configured to share a stress received by the supporting surface in response to an external force; wherein the support element is located along a periphery of the platform.

Claims 1, 2, 11-14, 23-29, and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Prior Art (as shown in applicant's figures 1A-1B). Prior Art of figures 1A-1B discloses a scanner with a case body (102) for a platform (110) of glass or acrylic resin as disclosed in applicant's specification comprising: a housing (102) having an opening on which the platform is placed, and one or more support elements (112) mounted on interior walls of the housing, at least one of the support elements comprising: a supporting surface (flat horizontal ledge of 112) on a top of each support element configured to contact the platform; and an absorbing body (the lower vertical section of 112 inherently shares the stress or weight received by the supporting surface or the flat horizontal ledge of 112 since it is supporting the ledge) located beneath the

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supporting surface configured to share a stress received by the supporting surface in response to an external force; wherein the support element is located along a periphery of the platform.

***Claim Rejections - 35 USC § 103***

Claims 3, 6, 9, 10, 15, 18, 21, and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art (as shown in applicant's figures 1A-1B) in view of Rohee (US patent no. 5,224,781). Prior Art of figures 1A-1B disclosed all the claimed features of applicant's invention except for the absorbing body is of "5" shaped. Rohee demonstrates it is old and well-known to make an absorbing body of a "5" shaped. To provide an absorbing body of "5" shaped would have been a matter of obvious design choice and is demonstrated by Rohee.

***Response to Arguments***

Applicant's arguments filed November 7, 2006 have been fully considered but they are not persuasive.

Applicant argues that applicant's recitation to a scanner platform throughout the claims is not a recitation of intended use but rather a functional limitation. In applicant's case examiner considers applicant's functional limitation is a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is examiner's assertion that

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Kakizaki's absorber which supports a platform of the circuit board type is also capable of supporting a platform of the scanner.

In regards to applicant's argument that examiner has not point to a disclosure in Kakazaki that the supporting surface is capable of contacting a platform of the scanner, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. One of ordinary skilled in the art would have understood that Kakazaki's shock absorber has the ability to support a platform such as a scanner platform. Such does not necessarily have to be specifically disclosed in Kakazaki. The ability to perform would have been understood by one of ordinary skill in the art.

Again, regarding the use of Admitted Prior Art disclosed in applicant's specification, applicant argues that the specification discloses that "the block members 112 are not sufficient to effectively absorb external shocks. Therefore when an external force is applied on the platform 110, the block member 112 can not absorb the shock". Examiner would also like to point out after the above citation, applicant discloses that "As a result, the platform 110 will likely be damaged due to stress concentration in the block members 112". This clearly indicates that the stress is being shared by the block members 112.

Indeed, applicant independent claims 1 and 13 recites that "the absorbing body located beneath the supporting surface capable of sharing an external stress received by the supporting surface in response to an external force". Clearly the supports or



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block members 112 that is in direct contact beneath the scanner platform will share any stress on the scanner platform thereabove. Consequently, the rejection stands.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571)272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Korie H. Chan  
Primary Examiner  
Art Unit 3632

khc  
November 17, 2006